Remarks / Arguments & Status

The application presently contains the following claims:

Independent Claim #	*Dependent Claim #s*
1	2-6
7	8, 10-12
13	14-18
19	20-21, 23, 25-26

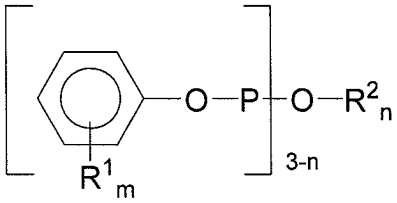
Claim #7 is amended in this response. Claims 9, 22 and 24 have been previously deleted.

The examiner has indicated that claims 1-6 contain allowable subject matter. The examiner has further represented that claims 16 and 23 would be allowable if rewritten to overcome the rejections under 35 U.S.C. §112, second paragraph and all of the limitations of the base claim and any intervening claims.

The applicant's attorney thanks the examiner for her thoughtful office action and would respectfully request that the examiner reevaluate some of her conclusions regarding rejected claims 7-8, 10-15, 27-21, and 25-26 in light of the arguments provided below, the terminal disclaimer attached as well as the claim to priority.

35 U.S.C. §102 Rejection & Responsive Arguments

In paragraph 1, the examiner has represented that claims 7-8, 10-15, 27-21, and 25-26 are rejected under this section, subparagraph (b) as being anticipated by Stevenson et al., (U.S. 2003/0001136). The examiner has represented that the Stevenson et al., (U.S. 2003/0001136) published application discloses phosphite eser additives for PVC and specifically identified that the reference at page 10 of the published application, third formula encompasses those of the applicant's formula II, thereby anticipating the identified claims.



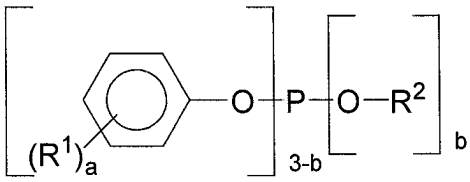
Wherein

R^1 is H, C_{1-18} alkyl, C_{1-18} alkoxy,

R^2 is C_{1-18} alkyl and

m is an integer from 1-2.

Prior Application



Wherein

R^1 is C_{8-12} alkyls and C_{8-12} alkoxy

R^2 is C_{8-16} alkyls

b is an integer from 1-2.

Present application

While generically, the formulas have similarities, a quick glance at the definition of the substituents for the Markush groups, clearly indicates that they are not identical, which is the necessary predicate for any rejection under this section. At best, the Prior Application represents a starting point for further experimentation, without providing any guidance as to how to narrow the definition of the "R" groups as ultimately determined. With all due respect for the examiner, it is submitted that there is no identity of teachings to sustain a rejection under this section.

In paragraph 2, the examiner has represented that claims 7-8, 10-15, 27-21, and 25-26 are rejected under this section, subparagraph (e) as being anticipated by Stevenson et al., (U.S. 2004/0183054).

Both applied references have a common assignee (Dover Chemical Corporation) as well as at least one common inventor, and therefore, any invention which was disclosed, but not claimed in either of the references, were not the invention "by another" as further illustrated in the attached Declaration made by Dr. Donald R. Stevenson under 37 C.F.R. §1.132.

Double Patenting

In paragraph 3, the examiner has provisionally rejected claims 7-8, 10-15, 17-21 and 25-26 on the ground of nonstatutory obviousness-type double patenting over the co-pending claims of Patent Application Serial No. 10/709,510 (published as U.S. 2004/0183054).

The examiner has indicated that the commonly assigned patent application Serial No. 10/709,510 would form the basis for a rejection of the claims under 35 U.S. C. §103(a) if the conflicting inventions were not commonly owned at the time the invention in this application was made. The examiner has suggested

that the applicant show that the conflicting inventions were commonly owned at the time the invention in this application was made.

Pursuant to the suggestion of the examiner, the applicant's attorney submits a terminal disclaimer.

35 U.S.C. §103 Rejection & Responsive Arguments

In paragraph 4 of the office action, the examiner has rejected claims 7-8, 10-15, 17-21 and 25-26 as being directed to subject matter which is not patentably distinct from claims 1, 4, 7, 9 and 14-16 of commonly assigned patent application serial no. 10/709,510. The examiner indicated that commonly assigned patent application 10/709,510 would form the basis for a rejection under this section, subparagraph (a) if the commonly assigned case qualified as prior art under 35 U.S.C. §102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order to assist the examiner resolve this issue, the examiner indicated that the assignee can, under 35 U.S.C. §103(c) and 37 C.F.R. §1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

Pursuant to the examiner's suggestion, the applicant's attorney is making a claim to priority to copending and commonly owned patent application serial no. 10/709,510. In making such claim, the applicant's attorney submits a Petition to effect such claim to priority as required by the late claiming of such in addition to the required Petition Fee.

In paragraph 5 of the office action, the examiner has rejected claims 7-8, 10-15, 17-21 and 25-26 under this section, subparagraph (a) as obvious over copending patent application Serial No. 10/709,510 (published as US 2004/0183054) would form the basis for a rejection of the claims under 35 U.S. C. §103(a) if the conflicting inventions were not commonly owned at the time the invention in this application was made. The examiner has suggested that the applicant show that the conflicting inventions were commonly owned at the time the invention in this application was made.

As stated in the attached declaration under 37 C.F.R. §1.131, the copending patent application and the instant invention are commonly owned by the same party, namely Dover Chemical Corporation and that the inventor named in the application is the prior inventor under 35 U.S.C. §104. Additionally, a properly executed terminal disclaimer is filed in accordance with 37 C.F.R. §1.321(c).

Prior Art made of Record, but not relied upon

The examiner has indicated that the following prior art has been made of record, but was not relied upon nor considered pertinent to the applicant's disclosure: US 2004/0164279; US 2004/0186207; US 6,824,711 corresponding to US 20030001136; and JP 49-20928 (corresponding to JP 74-020928).

Request for Reconsideration

Applicant believes that all independent claims clearly define over the prior art and that the distinctions between the present invention and the prior art would not have been obvious to one of ordinary skill in the art. Additionally, the remaining dependent claims, (including withdrawn dependent claims pursuant to the restriction and species election requirement) by the limitations contained in the base independent claims, are felt to be patentable over the prior art by virtue of their dependency from independent claims which distinguish over the prior art of record. All pending claims are thought to be allowable and reconsideration by the Examiner is respectfully requested.

It is respectfully submitted that no new additional searching will be required by the examiner.

Fee Determination Record

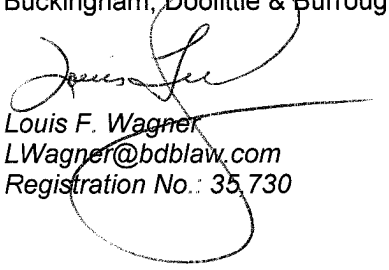
A fee determination sheet is attached for this amendment response. The Commissioner is hereby authorized to charge any additional fee required to effect the filing of this document to Account No. 50-0983.

Conclusion

It is respectfully submitted that all references identified by the examiner have been distinguished in a patentably novel and non-obvious way. If the examiner believes that a telephonic conversation would facilitate a resolution of any and/or all of the outstanding issues pending in this application, then such a call is cordially invited at the convenience of the examiner.

Buckingham, Doolittle & Burroughs, LLP
3800 Embassy Pkwy.
Akron, Ohio 44309-1500
(330) 258-6453 (telephone)
(330) 252-5452 (fax)
Attorney Docket #: 47399.0037

Respectfully Submitted,
Buckingham, Doolittle & Burroughs, LLP



Louis F. Wagner
LWagner@bdblaw.com
Registration No.: 35,730

«AK3:901523_v1»